REMARKS

The Office Action dated October 20, 2005 has been carefully reviewed and the foregoing amendment and following remarks have been made in consequence thereof.

Claims 1-18 are pending in this application. Claims 1-18 stand rejected. Claims 1, 6, and 12 have been amended herein. Claims 19 and 20 are newly added herein. No new matter has been entered. Upon entry of this Amendment, Claims 1-20 will be pending in this application.

The rejection of Claims 1-18 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter is respectfully traversed.

Independent Claims 1, 6, and 12, for reasons other than the Section 101 rejection, have each been amended to delete the recitation of "subjective assessment". Accordingly, for at least this reason, Claims 1, 6, and 12 are submitted as satisfying the requirements of Section 101.

Claims 2-5 depend from independent Claim 1. When the recitations of Claims 2-5 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-5 likewise satisfy the requirements of Section 101.

Claims 7-11 depend from independent Claim 6. When the recitations of Claims 7-11 are considered in combination with the recitations of Claim 6, Applicants submit that dependent Claims 7-11 likewise satisfy the requirements of Section 101.

Claims 13-18 depend from independent Claim 12. When the recitations of Claims 13-18 are considered in combination with the recitations of Claim 12, Applicants submit that dependent Claims 13-18 likewise satisfy the requirements of Section 101.

For at least the reasons set forth above, Applicants respectfully request the Section 101 rejection of Claims 1-18 be withdrawn.

Regarding new Claim 20, which recites, among other things, "prompting the user to make a subjective assessment of whether the candidate possesses at least one of a plurality of independent characteristics", Applicants respectfully submit that Claim 20 satisfies the requirements of Section 101. On page 2 of the Office Action, it is asserted that "[e]ach time

performing the [subjective] assessment will have different results because the assessment is subjective". However, whether a process will have different results each time it is performed is not a proper basis for a Section 101 rejection. For example, Applicants believe that there are many patentable processes that will have different results each time because of different variables. Moreover, Applicants submit that a "subjective assessment" will not necessarily have different results each time it is performed. For at least the reasons set forth above, Applicants respectfully submit that new Claim 20 satisfies the requirements of Section 101.

The rejection of Claims 1-18 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement is respectfully traversed.

Independent Claims 1, 6, and 12, for reasons other than the Section 112 rejection, have each been amended to delete the recitation of "subjective assessment". Accordingly, for at least this reason, Claims 1, 6, and 12 are submitted as satisfying the requirements of Section 112.

Claims 2-5 depend from independent Claim 1. When the recitations of Claims 2-5 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-5 likewise satisfy the requirements of Section 112.

Claims 7-11 depend from independent Claim 6. When the recitations of Claims 7-11 are considered in combination with the recitations of Claim 6, Applicants submit that dependent Claims 7-11 likewise satisfy the requirements of Section 112.

Claims 13-18 depend from independent Claim 12. When the recitations of Claims 13-18 are considered in combination with the recitations of Claim 12, Applicants submit that dependent Claims 13-18 likewise satisfy the requirements of Section 112.

For at least the reasons set forth above, Applicants respectfully request the Section 112 rejection of Claims 1-18 be withdrawn.

Regarding new Claim 20, which recites, among other things, "prompting the user to make a subjective assessment of whether the candidate possesses at least one of a plurality of independent characteristics", Applicants respectfully submit that Claim 20 satisfies the requirements of Section 112, first paragraph. On page 3 of the Office Action, it is asserted that "the specification does not disclose 'performing a _subjective_ assessment'." Applicants

respectfully disagree. For example, the specification, at page 3, lines 18-22, describes that "after candidate selection program 30 is accessed, a macro (not shown) automatically guides a user through a series of input selections 48. The macro prompts a user to enter a one or a zero within a plurality of candidate background categories 50 that represent qualifications of the specific candidate being assessed." As shown in Figure 3 and described at page 3, lines 28 and 29, and page 4, lines 1 and 2, respectively, the candidate background categories 50 may include "significant travel exposure" and "exceptional work experience". Accordingly, and for at least this reason, Applicants submit that performing a subjective assessment is described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For at least the reasons set forth above, Applicants respectfully submit that new Claim 20 satisfies the requirements of Section 112.

The rejection of Claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,275,812 (Haq) in view of U.S. Patent 6,662,194 (Joao) is respectfully traversed.

Haq describes a system and method for human resource skill management, training, career development, and deployment for the employees of a company. The system compares the employees' skills to skills required for a position within the company in a one to one correspondence. The method uses skill templates that enable a project manager to compare the employees skills with skills that are required by each member of the project team to assess the employee's suitability for a position. A weighting system is also used to establish the relative significance of various skills. An assessment of an employee's suitability for a project within the company is based on a quantitative evaluation and not based on subjective considerations.

Joao describes a method of providing job searching services, recruitment services and/or recruitment related services related to individuals, independent contractors, freelancers, employers and/or hiring entities. The method includes an individual entering data and/or information regarding his or her education, skills, work experience, objectives and/or any other data and/or information pertinent to a job search. At step 207, the individual will enter his or her job search, including any search criteria, into the central processing computer 10 via the individual computer 20. At step 209, the central processing computer 10 will provide the individual with the report or list of available jobs and the individual decides

whether to apply for any of the jobs. At step 215, the individual data and/or information is transmitted to the employer. The employer can ask for more information, for example, a resume, references, work samples, salary requirements, salary history, transcripts, or the employer can indicate that the employer in interested in the individual. If, at step 227, it is determined that the employer is interested in pursing the opportunity with the individual, the central processing computer 10 will, at step 230, put the employer and the individual in contact with each other by transmitting contact information to either or both of the employer and/or the individual. Notably, Joao does not describe or suggest selecting at least one candidate to interview based on the desired quality values, but rather, in contrast to the present invention, merely provides mutual contact information for an employer and an individual, who each have indicating they want to contact the other party.

Applicants respectfully traverse the assertion in the Office Action that "[t]he examiner interprets the circuit design skill as the predetermined desired quality of analytical ability, and the management skill as the pre-determined desired quality of interpersonal skill." The Office Action has not supplied any reference to support this assertion. The mere assertions that "[a] circuit designer must have the skill to design the circuit, and s/he must have the ability to analyze the requirement of a circuit, and have the ability to analyze and solve any problems encountered during the circuit design", and "[m]anagement skill is a type of interpersonal skill because the person need to communicate with the other person, and identify any problems between people, and solve the problem" does not support a prima facie obvious rejection. These assertions must always be supported by citation to some reference work recognized as standard in the pertinent art and the Applicants given the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. Applicants have not been provided with the citation to any reference supporting the assertions made in the rejection. The rejection, therefore, fails to provide the Applicants with a fair opportunity to respond to the rejection, and fails to provide the Applicants with the opportunity to challenge the correctness of the rejection.

Applicants respectfully traverse the assertion in the Office Action that "[h]aq teaches generating a database including at least one characteristic for each candidate wherein the at least one characteristic is correlative to the desired qualities." Haq describes an Employee Database (78) that includes the following information for each employee, Filled and approved skills assessment forms (79), a Target Career Template (80), which is a template of

skill indices that an employee sets as a target of achievement for him/herself after consulting with his/her manager, a Deployment schedule and geographical location (81), and Preference sheets indicating the employee's preferences for various assignments (82), but Haq does not describe or suggest generating a database including at least one characteristic for each candidate wherein the at least one characteristic is correlative to the desired qualities.

Further, and to the extent understood, no combination of Haq and Joao, considered alone or in combination,, describes or suggests the claimed combination, and as such, the presently pending claims are patentably distinguishable from the cited combination. Specifically, Claim 1 recites a method for determining candidates to interview that includes "providing pre-determined desired qualities for a candidate, the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills...prompting a user to determine and input into a computer whether the candidate possesses at least one of a plurality of independent characteristics, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities...generating a database including at least one characteristic for each candidate wherein the at least one characteristic is correlative to the desired qualities...normalizing the characteristics, normalizing includes comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the desired quality, and assigning a value to each desired quality based on the comparison...displaying results for each candidate based on the desired quality values...selecting at least one candidate to interview based on the desired quality values."

No combination of Haq and Joao describes or suggests a method for determining candidates to interview as recited in Claim 1. For example, neither Haq nor Joao describes or suggests prompting a user to determine and input into a computer whether the candidate possesses at least one of a plurality of independent characteristics, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities. Rather, Haq describes using ISDRM Query Software to search an ISDRM database and match the skills of an employee against a specific skills template. Joao does not make up for the deficiencies of Haq. Because Haq and Joao each individually fail to describe or suggest one or more elements of Claim 1, it follows that a combination of Haq

and Joao cannot describe or suggest such element(s). For at least the reasons set forth above, Claim 1 is submitted to be patentable over Haq in view of Joao.

Claims 2-5 depend from independent Claim 1. When the recitations of Claims 2-5 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-5 likewise are patentable over Haq in view of Joao.

Claim 6 recites a selection system for determining candidates to interview that includes "a database comprising at least one independent characteristic for each candidate, and pre-determined dependent desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills and wherein the at least one characteristic is correlative to the desired qualities, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities...a processor programmed to: prompt a user to determine whether the candidate possesses the at least one independent characteristic...normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality, and assigning a value to each of the desired qualities...display results for each candidate based on the desired quality values."

No combination of Haq and Joao describes or suggests a selection system for determining candidates to interview as recited in Claim 6. For example, neither Haq nor Joao describes or suggests a processor programmed to prompt a user to determine whether the candidate possesses the at least one independent characteristics. Rather, Haq describes using ISDRM Query Software to search an ISDRM database and match the skills of an employee against a specific skills template. Joao does not make up for the deficiencies of Haq. Because Haq and Joao each individually fail to describe or suggest one or more elements of Claim 6, it follows that a combination of Haq and Joao cannot describe or suggest such element(s). For at least the reasons set forth above, Claim 6 is submitted to be patentable over Haq in view of Joao.

Claims 7-11 depend from independent Claim 6. When the recitations of Claims 7-11 are considered in combination with the recitations of Claim 6, Applicants submit that dependent Claims 7-11 likewise are patentable over Haq in view of Joao.

Claim 12 recites an apparatus for screening candidates to interview that includes a processor having a memory and programmed to "a processor comprising a memory and programmed to "generate a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate wherein the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills, and wherein the at least one characteristic is correlative to the desired qualities, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities... prompt a user to determine whether the candidate possesses the at least one independent characteristic...normalize the characteristics by comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the dependent desired quality, and assigning a value to each of the desired qualities...display results for each candidate based on the desired quality values."

No combination of Haq and Joao describes or suggests an apparatus for screening candidates to interview as recited in Claim 12. For example, neither Haq nor Joao describes or suggests a processor programmed to prompt a user to determine whether the candidate possesses the at least one independent characteristics. Rather, Haq describes using ISDRM Query Software to search an ISDRM database and match the skills of an employee against a specific skills template. Joao does not make up for the deficiencies of Haq. Because Haq and Joao each individually fail to describe or suggest one or more elements of Claim 12, it follows that a combination of Haq and Joao cannot describe or suggest such element(s). For at least the reasons set forth above, Claim 12 is submitted to be patentable over Haq in view of Joao.

Claims 13-18 depend from independent Claim 12. When the recitations of Claims 13-18 are considered in combination with the recitations of Claim 12, Applicants submit that dependent Claims 13-18 likewise are patentable over Haq in view of Joao.

Moreover, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to modify Haq according to the teachings of Joao. More specifically, it is respectfully submitted that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the

prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

The Federal Circuit has determined that:

> [I]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, "it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Although it is asserted within the Office Action that Haq teach the present invention except for disclosing selecting at least one candidate to interview based on the desired quality values, and that Joao teaches selecting at least one candidate to interview based on the desired quality values, no motivation nor suggestion to combine Joao with Haq has been shown. However, Haq does not describe or suggest performing a subjective assessment that determines if the candidate possesses at least one of a plurality of independent characteristics. The Office Action asserts that Joao teaches of selecting at least one candidate to interview based on the desired quality values, but rather Joao describes the individual selects an employer and information is shared between the two until one is no longer interested in the other or mutual contact information is disclosed to each of them. Joao does not describe or suggest selecting at least one candidate to interview based on the desired quality values.

Since there is no teaching or suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 1-18 be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 1-18 be withdrawn.

Newly added Claims 19 and 20 depend from independent Claim 1, which is submitted to be in condition for allowance. When the recitations of dependent Claims 19 and 20 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 19 and 20 likewise is patentable over the cited art.
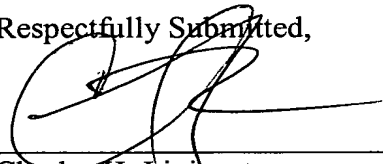
Claim 19 further recites "wherein prompting a user to determine and input into a computer whether the candidate possesses at least one of a plurality of independent characteristics comprises prompting the user to determine and input into the computer whether the candidate possesses at least one of a grade point average greater than 3.5 out of 4.0, multiple degrees, multiple majors, multiple minors, an honor society membership, a society officer position, a team captain position, military service, significant travel exposure, education outside a home country of the candidate, community service participation, tutor experience, technical publication, awards, exceptional work experience, and extracurricular activities." None of the cited art, considered alone or in combination, describes or suggests prompting the user to determine and input into the computer whether the candidate possesses at least one of a grade point average greater than 3.5 out of 4.0, multiple degrees, multiple majors, multiple minors, an honor society membership, a society officer position, a team captain position, military service, significant travel exposure, education outside a home country of the candidate, community service participation, tutor experience, technical publication, awards, exceptional work experience, and extracurricular activities. For at least this additional reason, Claim 19 is submitted to be patentable over the cited art.

Claim 20 further recites "wherein prompting a user to determine and input into a computer whether the candidate possesses at least one of a plurality of independent characteristics comprises prompting the user to make a subjective assessment of whether the candidate possesses at least one of a plurality of independent characteristics." None of the

cited art, considered alone or in combination, describes or suggests prompting the user to make a subjective assessment of whether the candidate possesses at least one of a plurality of independent characteristics. For at least this additional reason, Claim 20 is submitted to be patentable over the cited art.

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

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